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PATENT GROUP
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BOSTON MA 02210-2600

MAY 10 2010
OFFICE OF PETITIONS

In re Patent No. 7,531,168 : DECISION ON REQUEST FOR
O'HARA et al. : RECONSIDERATION OF
Issue Date: May 12, 2009 : PATENT TERM ADJUSTMENT AND
Application No. 10/076,934 : NOTICE OF INTENT TO ISSUE
Filed: February 15, 2002 : CERTIFICATE OF CORRECTION
Attorney Docket No. WYS-00701 :

This is a decision on the petition filed on July 8, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred ninety-four (594) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein**. The term of the above-identified patent is extended or adjusted by **four hundred seventy-three (473) days**.

A review of the application history reveals that a period of reduction of 43 days was entered under 37 CFR 1.704(c)(10) for the filing of a "REQUEST TO RE-APPLY FEES PREVIOUSLY PAID" on March 31, 2009. It is noted that the submission of a Fee(s) Transmittal (PTOL-85B) is identified as one of the papers the filing of which the Director has specifically deemed not to be a "failure to engage in reasonable efforts" within the meaning of 37 CFR 1.704 (c)(10). See MPEP 2732. Under the circumstances, no reduction is warranted for the filing of the paper requesting

only that the previously paid issue fee be reapplyed. Thus, the reduction of 43 days is not merited and will be removed.

The record further reveals that patentee have been assessed delay under 37 CFR 1.704(c)(10) for the submission of the Supplemental Information Disclosure Statement (IDS) on November 6, 2008, the Request for Continued Examination (RCE) and IDS on November 10, 2008, and the petition to withdraw from issue on December 3, 2008.

37 CFR 1.704(c)(10) provides:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that patentee submitted the IDS on November 6, 2008, the RCE and IDS on November 10, 2008, and the petition to withdraw from issue on December 3, 2008, after the mailing of the notice of allowance on July 16, 2008 (and payment of the issue fee on October 16, 2008). Furthermore, a review of IDS submitted on November 6, 2008, and November 10, 2008, reveals that they did not include a proper statement under § 1.704(d).¹ Thus, patentee failed to engage in reasonable

¹ The Office reminds patentee that 37 CFR 1.704(d) was revised, effective May 24, 2004. Specifically, "Section 1.704(d) [was] amended to change 'cited in a communication' to 'first cited in any communication' in order to clarify that the item must have been first cited in any communication from a foreign patent office in a counterpart application instead of merely being cited in such a communication." 69 FR 21704 (Apr. 22, 2004) (Emphasis added). Therefore, the required statement under 37 CFR 1.704(d) reads, in pertinent part, that:

efforts to conclude prosecution of the application pursuant to 37 CFR 1.704(c)(10).

Pursuant to 37 CFR 1.704(c)(10), patentee should have been assessed the following periods of reduction:

- 56 days for the submission of the IDS on November 6, 2008, after the mailing of the notice of allowance (and payment of the issue fee), from November 6, 2008, the date the IDS was filed, to December 31, 2008, the mailing date of the notice of allowance in response to the IDS.
- 52 days for the submission of the RCE and IDS after the mailing of the notice of allowance (and payment of the issue fee) on November 10, 2008, from November 10, 2008, the date the RCE and amendment were filed, to December 31, 2008, the mailing date of the notice of allowance in response to the RCE and IDS; and,
- 2 days for the submission of the petition to withdraw from issue after the mailing of the notice of allowance (and payment of the issue fee) on December 3, 2008, from December 3, 2008, the date the petition was filed, to December 4, 2008, the mailing date of the decision in response to the petition.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." (Emphasis added).

[E]ach item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

(Emphasis added).

In this instance, the periods under 37 CFR 1.704(c)(10) overlap. Specifically, the period of reduction for the submission of the IDS on November 6, 2008, from November 6, 2008 to December 31, 2008, completely overlaps the other periods of reduction. Therefore, a single period of reduction of 56 days will be entered.

With regard to the delay under 37 CFR 1.702(b), patentee is reminded that the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the B delay period. Thus, the over three year period begins on February 16, 2005, and ends on May 17, 2006, the day before the RCE was filed, and is 456 (not 457) days. See 35 U.S.C. 154(b)(1)(B)(i).

Further, the Office notes that patentee failed to account for the filing of the notice of appeal on March 15, 2006. The Office reminds patentee that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii).

In this instance, the period consumed by appellate review is 64 days, beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, March 15, 2006, and ending on the day before the filing of the RCE, May 17, 2006. Thus, B delay is 392 days (456 - 64).

In view of the above, the patent term adjustment is 473 days (507 days of A delay + 392 days of B delay - 426 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office

will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred seventy-three (473) days.**

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT: 7,531,168 B2

DATED: May 12, 2009

DRAFT

INVENTOR(S): O'Hara et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 94 days

Delete the phrase "by 94 days" and insert – by 473 days--

PALM INTRANET

Day : Sunday
 Date: 5/9/2010
 Time: 14:50:12

PTA Calculations for Application: 10/076934

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|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 02/15/2002 | PTO Delay (PTO): | 507 |
| Issue Date of Patent: | 05/12/2009 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 413 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 473 |
| PTO Delay Adjustment: | 379 | | |

File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|--------|------------|---|-----|------|-------|
| 145 | 05/09/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 392 | | |
| 144 | 05/09/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 392 | | |
| 143 | 05/09/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 392 | |
| 142 | 05/09/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 56 | |
| 141 | 05/09/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 43 | | |
| 136.5 | 04/22/2009 | PTA 36 MONTHS | | | |
| 136 | 05/12/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 135 | 04/06/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 134 | 04/03/2009 | DISPATCH TO FDC | | | |
| 133 | 04/02/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 132 | 03/31/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 131 | 03/31/2009 | MISCELLANEOUS INCOMING LETTER | | 43 | |
| 130 | 03/31/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 128 | 03/24/2009 | MAIL-PETITION DECISION - DISMISSED | | | |
| 127 | 03/24/2009 | PETITION DECISION - DISMISSED | | | |
| 126 | 01/02/2009 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 125 | 12/31/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 124 | 12/29/2008 | ISSUE REVISION COMPLETED | | | |
| 123 | 12/29/2008 | DOCUMENT VERIFICATION | | | |
| 122 | 12/29/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 121 | 12/22/2008 | NOTICE OF ALLOWABILITY | | | |
| 120 | 11/10/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 119 | 12/22/2008 | DATE FORWARDED TO EXAMINER | | | |
| | | REQUEST FOR CONTINUED EXAMINATION | | | |

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|-----|------------|---|--|--|
| 118 | 11/10/2008 | (RCE) | | |
| 117 | 12/22/2008 | DISPOSAL FOR A RCE / CPA / R129 | | |
| 112 | 12/04/2008 | MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE | | |
| 111 | 12/04/2008 | RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE | | |
| 110 | 12/03/2008 | PETITION ENTERED | | |
| 108 | 10/28/2002 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | |
| 107 | 11/10/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | |
| 106 | 11/06/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | |
| 105 | 11/10/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | |
| 104 | 11/10/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | |
| 103 | 11/06/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | |
| 102 | 11/06/2008 | REFERENCE CAPTURE ON IDS | | |
| 101 | 11/06/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | |
| 100 | 10/16/2008 | PETITION ENTERED | | |
| 99 | 10/16/2008 | ISSUE FEE PAYMENT VERIFIED | | |
| 98 | 10/16/2008 | ISSUE FEE PAYMENT RECEIVED | | |
| 97 | 09/17/2008 | FINISHED INITIAL DATA CAPTURE | | |
| 96 | 07/24/2008 | SEQUENCE FORWARDED TO PUBS ON TAPE | | |
| 95 | 07/18/2008 | EXPORT TO INITIAL DATA CAPTURE | | |
| 94 | 10/28/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | |
| 93 | 07/16/2008 | MAIL EXAMINER'S AMENDMENT | | |
| 92 | 07/16/2008 | MAIL NOTICE OF ALLOWANCE | | |
| 91 | 07/14/2008 | ISSUE REVISION COMPLETED | | |
| 90 | 07/14/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | |
| 89 | 07/14/2008 | CASE DOCKETED TO EXAMINER IN GAU | | |
| 88 | 07/14/2008 | DOCUMENT VERIFICATION | | |
| 87 | 07/14/2008 | EXAMINER'S AMENDMENT COMMUNICATION | | |
| 86 | 07/14/2008 | NOTICE OF ALLOWABILITY | | |
| 82 | 05/07/2008 | DATE FORWARDED TO EXAMINER | | |
| 81 | 04/24/2008 | RESPONSE AFTER NON-FINAL ACTION | | |

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|----|------------|--|----|----|--|
| 80 | 05/05/2008 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 79 | 01/24/2008 | MAIL NON-FINAL REJECTION | | | |
| 78 | 01/22/2008 | NON-FINAL REJECTION | | | |
| 77 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 76 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | 0 | 70 | |
| 75 | 10/31/2007 | REFERENCE CAPTURE ON IDS | | | |
| 74 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 73 | 11/24/2007 | DATE FORWARDED TO EXAMINER | | | |
| 72 | 10/31/2007 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 71 | 11/24/2007 | DATE FORWARDED TO EXAMINER | | | |
| 70 | 10/31/2007 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 69 | 11/24/2007 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 68 | 10/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 67 | 10/31/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 66 | 09/26/2007 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 65 | 09/25/2007 | ADVISORY ACTION (PTOL-303) | | | |
| 64 | 09/11/2007 | DATE FORWARDED TO EXAMINER | | | |
| 63 | 09/10/2007 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 62 | 09/10/2007 | NOTICE OF APPEAL FILED | 94 | 56 | |
| 61 | 09/10/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 58 | 08/04/2003 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 57 | 08/04/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 56 | 03/08/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 55 | 03/05/2007 | FINAL REJECTION | | | |
| 54 | 02/01/2007 | DATE FORWARDED TO EXAMINER | | | |
| 53 | 01/25/2007 | RESPONSE AFTER NON-FINAL ACTION | 92 | 49 | |
| 52 | 01/25/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 51 | 12/26/2006 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |

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| 50 | 12/20/2006 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 49 | 07/25/2006 | MAIL NON-FINAL REJECTION | | | |
| 48 | 07/20/2006 | NON-FINAL REJECTION | | | |
| 47 | 05/24/2006 | DATE FORWARDED TO EXAMINER | | | |
| 46 | 03/15/2006 | RCE- AF PROCESSED | | | |
| 45 | 05/24/2006 | DATE FORWARDED TO EXAMINER | | | |
| 44 | 05/18/2006 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 43 | 05/24/2006 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 42 | 05/18/2006 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 41 | 04/10/2006 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 40 | 04/05/2006 | ADVISORY ACTION (PTOL-303) | | | |
| 39 | 03/27/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 38 | 03/27/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 37 | 03/17/2006 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 03/15/2006 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 35 | 03/15/2006 | NOTICE OF APPEAL FILED | | 91 | 33 |
| 34 | 03/15/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 33 | 09/14/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 32 | 09/12/2005 | FINAL REJECTION | | | |
| 31 | 07/08/2005 | DATE FORWARDED TO EXAMINER | | | |
| 30 | 06/27/2005 | RESPONSE AFTER NON-FINAL ACTION | | 92 | 27 |
| 29 | 06/27/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 28.7 | 06/27/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 28 | 06/27/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 27 | 12/27/2004 | MAIL NON-FINAL REJECTION | | | |
| 26 | 12/21/2004 | NON-FINAL REJECTION | | | |
| 25 | 11/10/2004 | DATE FORWARDED TO EXAMINER | | | |
| 24 | 11/02/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 23 | 11/02/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 22 | 11/02/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 21 | 09/03/2004 | MAIL RESTRICTION REQUIREMENT | 507 | | -1 |

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|----|------------|--|---|---|
| 20 | 09/01/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | |
| 19 | 06/28/2004 | CASE DOCKETED TO EXAMINER IN GAU | | |
| 18 | 04/06/2004 | CASE DOCKETED TO EXAMINER IN GAU | | |
| 17 | 07/10/2003 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | |
| 15 | 11/02/2002 | CASE DOCKETED TO EXAMINER IN GAU | | |
| 14 | 06/19/2002 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | |
| 13 | 06/19/2002 | NEW OR ADDITIONAL DRAWING FILED | | |
| 12 | 08/20/2002 | APPLICATION DISPATCHED FROM OIPE | | |
| 11 | 07/31/2002 | APPLICATION IS NOW COMPLETE | | |
| 10 | 06/19/2002 | ADDITIONAL APPLICATION FILING FEES | 1 | 5 |
| 9 | 06/19/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | |
| 8 | 06/19/2002 | APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS | | |
| 7 | 07/15/2002 | MAIL-RECORD PETITION DECISION OF GRANTED RELATED TO FILING DATE | | |
| 6 | 06/19/2002 | PETITION ENTERED | | |
| 5 | 03/18/2002 | NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED | | |
| 4 | 03/14/2002 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | |
| 3 | 03/02/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | |
| 2 | 02/19/2002 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | |
| 1 | 02/19/2002 | INITIAL EXAM TEAM NN | | |

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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